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IN THE

Supreme Court of the United States

OCTOBER TERM, 1963.

No. 976

JOHNSON & JOHNSON,

Petitioner,

vs.

THE KENDALL COMPANY,

Respondent.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT.

PETITIONER'S REPLY MEMORANDUM.

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THE GUNTHORP-WARREN PRINTING COMPANY, CHICAGO

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Improper liberties taken by respondent with the opinion below—designed to obscure the "Question Presented"—make this brief response necessary.

Respondent has rewritten the opinion of the Court of Appeals to include (a) a non-existent rejection of findings of the District Court "as clearly erroneous" (Respondent's Brief, p. 2), and (b) two of respondent's products alleged to antedate the actual invention of petitioner's patentee (R. Br. 6-7). Thus, conceding that the Court "did not refer specifically" to prior art which was fairly enough (prior to 1945) to support its invalidation of the Gross patent as obvious, respondent points to two of its own products (Wet Pruf and Double Seal) which allegedly

were early enough (1937-38) and which respondent says were intended to be included by the Court of Appeals "in the generality of its statement." However, since the District Court had expressly considered and rejected both items and the Court of Appeals chose to remain silent as to them, there is a strong presumption against respondent's assertions.* This is confirmed by the Court's statement that it was considering lack of invention as a "matter of law" (Petition, ix) and its reliance for this purpose upon 1949 and 1950 products.

1. Concerning the Wet Pruf product of 1937 now relied on by respondent (R. Br. 6), the District Court found (Petition, xxi):

> "These exhibits and the testimony of defendant's witnesses concerning the Wet Pruf tape do not show that any aspect of the Gross invention was known, recognized, or in use by others before Gross."

This tape was not discussed by the Court below. Its opinion does not examine the evidence relating to the product and the finding of fact of the District Court which disposed of it (Petition, xx-xxi) was left undisturbed.

2. Similarly, the Court below did not mention the Double Seal (Holland cloth) tape or the Kemp report of 1938 now discussed by respondent (R. Br. 6-7). Findings 62 and 63 relating to these items (Def. Appendix I, 46-47) were not set aside. Neither did the Court disturb Finding No. 82 which in part also referred to the Double Seal tape and the Kemp report and which held that respondent "did not learn anything of the Gross invention" either from its own product or the experimental work of Kemp (Petition, xxiii).

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*As only one unrelated "finding" was singled out as error (Petition, viii; see Respondent's Brief, p. 5), it is most incongruous for respondent to assert that other findings were "necessarily set aside."

The Kemp report was a *private* communication and not a part of the prior art. Kemp specifically rejected the use of his facing for adhesive bandages (Finding No. 63, Def. App. I, 47); and contrary to respondent's assertion that the product "was sold by defendant from 1938 to 1942" (R. Br. 6) the express undisturbed finding of fact was that defendant had not (Def. App. I, 46-47):

> "offered sufficient evidence from which it could be found that the Double Seal tape was actually sold or on sale in 1938-1942 as alleged."

3. Absent the facts and rulings improperly grafted on it by respondent, the opinion of the Court of Appeals squarely presents the specific question raised by the petition, and respondent's discussion (R. Br. 9) of the so-called contemporary inventor doctrine is completely beside the point. To the extent that this Court's decisions in *Thomson Spot Welder Co.* v. *Ford Motor Co.*, 265 U. S. 445, 453 (1924) and *Concrete Appliances Co.* v. *Gomery*, 269 U. S. 177, 185 (1925), rely on fact subsequent to the actual date of invention, they do so only for the purpose of buttressing a separate, early enough, basis for the holding of invalidity. These cases were cited in the respondent's brief in the Court of Appeals, but the rule they stand for was not invoked by the Court below because it was obviously inapplicable, there being nothing early enough (prior to 1945) on which the Court could rest its judgment of invalidity.

Moreover, the discussion at pages 9 and 10 of respondent's brief serves to emphasize the importance of the question of statutory construction tendered by the instant petition. Even if it were true, contrary to the fact, that the Court below reasoned as respondent has supposed, this Court, in view of the specific conflict in the circuits as to the validity of petitioner's patent, should settle the question of the true meaning and application of Section 103 in the light of *Thomson* and *Concrete*.

We respectfully submit that the writ prayed for should be granted.

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